

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTORNEY DOCKET № 13315US02

In the Application of:	)	
Christopher Pasqualino	)	
	)	
Serial No.: 10/034,414	)	<b>Electronically Filed on 21-NOV-2007</b>
	)	
Filed: December 27, 2001	)	
	)	
For: VIDEO ENCODING SCHEME	)	
SUPPORTING THE TRANSPORT	)	
OF AUDIO AND AUXILIARY	)	
INFORMATION	)	
	)	
Group Art Unit: 2621	)	
	)	
Confirmation No. 1160	)	
	)	
Examiner: Philippe, Gims S.	)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the final Office Action mailed on March 21, 2007 (hereinafter, the Final Office Action) **with a period of reply through November 21, 2007, pursuant to the Petition for Three Month Extension of Time.** No amendments are being filed with this request.

**A Notice of Appeal was already filed on June 21, 2007.** The review is being requested for the reasons stated on the attached sheets.

## REMARKS

The present application includes pending claims 1-21, all of which have been rejected. Claims 1-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Mair, et al., US Patent Application Publication № 2002/0186322 ("Mair"). Claims 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mair. The Applicant respectfully submits that the claims define patentable subject matter. The Applicant also respectfully traverses these rejections at least for the following reasons:

### I. Examiner's Reference Does Not Comply with 35 U.S.C. § 112, 1<sup>st</sup> ¶

The Applicant notes that Mair was filed on October 15, 2001 and claims priority to provisional application, Serial No. 60/296,924, filed June 8, 2001 (hereinafter, "the '924 Application"). The Examiner is referred to the following citation from the MPEP:

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions **<if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph>**.

See the M.P.E.P. § 2136.03 (Emphasis Added). The Applicant points out that the '924 Application is in fact less than two pages representing a "proposal for audio transport while maintaining backwards compatibility." Furthermore, the '924 Application does not disclose any of the FIGS. 1-5, which were disclosed in Mair. In essence, the '924 Application summarizes the use of the 8 bit/10 bit encoding process, which is a part of the disclosure in Mair. The Applicant respectfully submits that **the '924 Application does not properly "support the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph."** For example, with respect to independent claims

1, 12, 13, and 18, the Examiner relies on [0042], lines 4-6, [0033], lines 7-19, [0035], lines 7-16, [0042], and [0043]. See the Final Office Action at pages 3-4. As stated above, **the '924 Application describes the use of the extra bits (Bit 8 and Bit 9) and it does not support any of the citations that the Examiner relies on (e.g., [0042], lines 4-6, [0033], lines 7-19, [0035], lines 7-16, [0042], and [0043]), nor does it support any of the Figures 1-5 of Mair, corresponding to the above citations used in the Examiner's rejections.**

Therefore, since the '924 Application does not properly support the subject matter relied upon to make the rejection, the 35 U.S.C. 102(e) critical date of Mair should not be the filing date of the '924 Application, but rather the filing date of the utility application, which is October 15, 2001. Since the present application has a priority date August 17, 2001, Mair is not prior art under 35 U.S.C. 102(e) or under 35 U.S.C. 103(a). Accordingly, the Applicant respectfully traverses the rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a).

Accordingly, the Examiner is requested to withdraw the rejections to claims 1-21.

## **II. Mair Does Not Support the Examiner's Rejections**

Even assuming for the sake of argument that the '924 Application complies with 35 USC § 112, 1<sup>st</sup> ¶ (which the Applicant maintains that it does not), the Examiner's argument regarding the rejection of claims 1-18 under 35 U.S.C. § 102(e) is still deficient. For example, the Applicant submits that Mair does not disclose or suggest at least the limitation of "encoding said first data based on a state of at least one bit of said second data," as recited in Applicant's claim 1.

In his Final Office Action, the Examiner relies for support on lines 7-19 of [0033] and lines 7-16 of [0035]. See the Final Office Action at page 4. The Applicant respectfully disagrees. Paragraphs [0033] and [0035] of Mair relate to prior art Figures 1 and 2, respectively. More specifically, paragraph [0033] and Figure 1 relate to the DVI 1.0 encoding algorithm, and paragraph [0035] and

Figure 2 relate to various DVI encoding concepts. Paragraphs [0033] and [0035], as well as Figures 1 and 2 of Mair, do not disclose or suggest that encoding of first data based on a state of at least one bit from second data, as recited in Applicant's claim 1.

With regard to Examiner's "Response to Arguments" section in the Final Office Action, it seems that the Examiner is also relying on the use of bits 8 and 9 by Mair. This argument is also deficient as it does not provide any support for what is recited in Applicant's claim 1. For example, Mair discloses that bit 8 is used to indicate a translation that the data may go through for the purpose of transition minimization. *See* Mair at ¶ 0019. Mair also discloses that bit 9 is used to indicate optional inversion of bits 0 through 7. *See id.* at ¶ 0020. However, neither bit 8 nor bit 9 is used by Mair for purposes of encoding any data.

Therefore, the Applicant maintains that Mair does not disclose or suggest at least the limitation of "encoding said first data based on a state of at least one bit of said second data," as recited in Applicant's claim 1. Consequently, the Applicant submits that the rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) should be withdrawn.

### **III. Conclusion**

The Applicant respectfully submits that all claims 1-21 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: 21-NOV-2007

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